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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/358,529	07/22/1999	FUJIO NOGUCHI	450100-02002	1683

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NEW YORK, NY 10151

EXAMINER

WU, DOROTHY

ART UNIT	PAPER NUMBER
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2697

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DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/358,529

Applicant(s)

NOGUCHI ET AL.

Examiner

Dorothy Wu

Art Unit

2697

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Acknowledgement is made of the amendments to the claims, filed on July 28, 2003. The rejection of claim 4 under 35 USC 112, second paragraph has been withdrawn.
2. Applicant's arguments with respect to claims 2-6 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Wakui, U.S. Patent 5,648,816.

Regarding claim 2, Wakui teaches an image capturing apparatus (still video camera **1**) comprising first operation means (IC memory card control circuit **15**) for recording an image-capturing signal on a first recording medium (IC memory card **31**) in accordance with a first recording mode (memory card record mode) (col. 5, lines 43-46, 53-56; Fig. 4), second operation means (flash memory control circuit **19**) for recording an image-capturing signal on a second recording medium (image flash memory **20**) in accordance with a second recording mode (flash memory record mode) (col. 6, lines 32-38; Fig. 5), and detection means (memory card

Art Unit: 2697

detecting circuit 16) for detecting the loading of said first recording medium (IC memory card 31) (col. 5, lines 64-67). Wakui also teaches that when the first recording medium (IC memory card 31) is loaded, images are recorded on the first recording medium (IC memory card 31), which reads on the setting of the first recording mode when the first recording medium is detected (col. 19, lines 17-19, Fig. 16). The control means for setting the recording mode is inherently taught.

Regarding claim 3, Wakui teaches an image capturing apparatus (still video camera 1) that can switch between a first operation mode (memory card record mode) for recording an image-capturing signal on a first recording medium (IC memory card 31) and a second operation mode (flash memory record mode) for recording an image-capturing signal on a second recording medium (image flash memory 20) (col. 8, lines 24-41, 54-60), and detection means (memory card detecting circuit 16) for detecting the loading of said first recording medium (IC memory card 31) (col. 5, lines 64-67). The control means for switching the operation mode is inherently taught. Wakui teaches that when the IC recording medium is loaded into the camera, the camera stops recording in the flash memory and starts recording in the IC recording medium, which reads upon the switching of the operation mode to said first operation mode when said detection means detects that said first recording medium (IC memory card) is loaded (col. 19, lines 17-19, Fig. 16).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2697

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakui, U.S. Patent 5,648,816 in view of Honda, U.S. Pub. No. 2001/0014202.

Regarding claim 4, Wakui teaches an image capturing apparatus (still video camera **1**) that can switch between a first operation mode (memory card record mode) for recording an image-capturing signal on a first recording medium (IC memory card **31**) and a second operation mode (flash memory record mode) for recording an image-capturing signal on a second recording medium (image flash memory **20**) (col. 8, lines 24-41, 54-60); and detection means (memory card detecting circuit **16**) for detecting the loading of said first recording medium (col. 5, lines 64-67). The control means for switching the operation mode is inherently taught. Wakui teaches that when the IC recording medium is loaded into the camera, the camera stops recording in the flash memory and starts recording in the IC recording medium, which reads upon the switching of the operation mode to said first operation mode when said detection means detects that said first recording medium (IC memory card) is loaded (col. 19, lines 17-19, Fig. 16).

Wakui does not teach that in the first operation mode, the image sensing apparatus records an image-capturing signal as a still picture and in the second operation mode, the image sensing apparatus records the signal as a moving picture. Honda does teach that in a first operation mode P_H , the image sensing apparatus records an image-capturing signal as a still picture and in a second operation mode M_V , the image sensing apparatus records the signal as a moving picture [0079]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of choosing a particular operation

mode when a first recording medium is inserted taught by Wakui with the practice of recording still images in one mode and moving images in another taught by Honda to make an apparatus wherein the image sensing apparatus switches to a mode to take still images when an image recording medium is inserted. One of ordinary skill would have been motivated to make such a modification to assign one recording mode as the default mode but give the other mode priority when a recording medium is inserted.

Regarding claim 5, Wakui teaches an image capturing apparatus (still video camera **1**) that can switch between a first operation mode (memory card record mode) for recording an image-capturing signal on a first, card recording medium (IC memory card **31**) and a second operation mode (flash memory record mode) for recording an image-capturing signal on a second recording medium (image flash memory **20**) (col. 8, lines 24-41, 54-60); and detection means (memory card detecting circuit **16**) for detecting the loading of the card recording medium, which reads on the determining of whether said card recording medium is loaded (IC memory card **31**) (col. 5, lines 64-67). Wakui teaches that when the IC recording medium is loaded into the camera, the camera stops recording in the flash memory and starts recording in the IC recording medium, which reads upon the switching of the operation mode to said first operation mode when said detection means detects that said first recording medium (IC memory card) is loaded (col. 19, lines 17-19, Fig. 16).

Wakui does not teach that in the second mode, the image sensing apparatus records the image-capturing signal as a moving picture on a tape recording medium. Honda does teach that in a second mode M_v , the image sensing apparatus records the image-capturing signal as a moving picture [0079] on a tape recording medium [0061, 0074]. Therefore, it would have been

Art Unit: 2697

obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of choosing a particular operation mode when a card recording medium is inserted taught by Wakui with the practice of recording still images on a card recording medium in a first mode and moving images on a tape recording medium in a second mode taught by Honda to make an apparatus wherein the image sensing apparatus switches to a mode to take still images on a card recording medium when a card recording medium is inserted. One of ordinary skill would have been motivated to make such a modification to make the video recording mode the default mode but give still image pickup priority when a card recording medium is inserted.

Regarding claim 6, Wakui teaches an image capturing apparatus (still video camera **1**) comprising first operation means (IC memory card control circuit **15**) for recording an image-capturing signal on a card recording medium (IC memory card **31**) in accordance with a first recording mode (memory card record mode) (col. 5, lines 43-46, 53-56; Fig. 4), second operation means (flash memory control circuit **19**) for recording an image-capturing signal on a second recording medium (image flash memory **20**) in accordance with a second recording mode (flash memory record mode) (col. 6, lines 32-38; Fig. 5), and detection means (memory card detecting circuit **16**) for determining whether said card recording medium (IC memory card **31**) is loaded (col. 5, lines 64-67). Wakui also teaches that when the card recording medium (IC memory card **31**) is loaded, images are recorded on the first recording medium (IC memory card **31**), which reads on the setting of the first recording mode (memory card record mode) when said detection means detects that said card recording medium is loaded (col. 19, lines 17-19, Fig. 16). The control means for setting the recording mode is inherently taught.

Wakui does not teach that the second operation means records on a tape recording medium. Honda teaches an apparatus in which there is a second mode M_V in which the image sensing apparatus records the image-capturing signal as a moving picture [0079] on a tape recording medium [0061, 0074]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of choosing a particular operation mode when a card recording medium is inserted taught by Wakui with the practice of recording images on either a card recording medium or a tape recording medium taught by Honda to make an apparatus wherein the image sensing apparatus switches to a mode to record images on a card recording medium when a card recording medium is inserted. One of ordinary skill would have been motivated to make such a modification to make the mode in which images are captured on a tape recording medium the default mode but give priority to capturing images on a card recording medium when a card recording medium is inserted.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2697

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dorothy Wu whose telephone number is 703-305-8412. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-7644.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

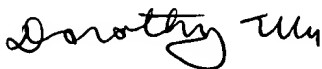
Washington, D.C. 20231

Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703)306-0377.



DW
September 25, 2003



ANDREW CHRISTENSEN
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